REMARKS

By this Amendment, Applicants amend independent claims 1, 8, 12, and 16.

Support for the amendments can be found in the specification at, for example, page 11,

lines 7-11. Claims 1, 2, 5-9, 11-14, and 16-18 are pending in this application.

In the Office Action,[1] the Examiner provisionally rejected claims 1, 6, 7, 12, 14,

16, and 18 on the ground of non-statutory obviousness-type double patenting over

claims 6, 10, 12, and 14 of copending Application No. 10/658,684 ("the '684

application") in view of U.S. Patent No. 7,003,482 to Margoscin et al. ("*Margoscin*");

rejected claims 1, 5-8, 11, 12, 14, 16, and 18 under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent No. 7,007,278 to Gungabeesoon ("*Gungabeesoon*") in

view of *Margoscin*; and rejected claims 2, 9, 13, and 17 under 35 U.S.C. § 103(a) as

being unpatentable over *Gungabeesoon* in view of *Margoscin* and "Database

Performance in the Real World: TPC-D and SAP R/3" by Doppelhammer et al.

("*Doppelhammer*").

Provisional Non-Statutory Obviousness-Type Double Patenting Rejection

Applicants respectfully traverse the provisional non-statutory obviousness-type

double patenting rejection of claims 1, 6, 7, 12, 14, 16, and 18, and request that the

rejection be held in abeyance. To the knowledge of the undersigned, the '684

application is currently pending and, thus, no double patenting circumstances can arise

until a patent is granted. Since a patent has not yet issued from the '684 application,

---

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully request that the provisional rejection be held in abeyance and any resolution in the form of a terminal disclaimer or otherwise be deferred.

Rejection of Claims 1, 5-8, 11, 12, 14, 16, and 18 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 5-8, 11, 12, 14, 16, and 18 under 35 U.S.C. § 103(a) as being anticipated by *Gungabeesoon* in view of *Margoscin*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2142(III), 8th Ed., Rev. 6 (Sept. 2007). "[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:

(A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art; and

(C) Resolving the level of ordinary skill in the pertinent art."

M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Independent claim 8, as amended, calls for a combination including, for example, "the run-time code comprising a flag indicating whether the run-time code was generated from a native design-time representation or a converted design-time representation."

The Examiner alleges that the JavaServer page of *Gungabeesoon* corresponds to the claimed "run-time code." Office Action at 6. Even assuming the Examiner's allegation is correct, which is it not, *Gungabeesoon* does not disclose that the JavaServer page "compris[e] a flag indicating whether the [JavaServer page] was generated from a native design-time representation or a converted design-time representation," as recited in claim 1. *Gungabeesoon* is silent with respect to any flag or indication of a representation that generated the JavaServer page. Therefore, *Gungabeesoon* fails to teach or suggest "the run-time code comprising a flag indicating whether the run-time code was generated from a native design-time representation or a converted design-time representation," as recited in claim 1.

Furthermore, the Examiner alleges that "Margoscin teaches that the middleware program . . . performs a function comprising input validation." Office Action at 9. Even assuming the Examiner's allegation is correct, which it is not, *Margoscin* fails to cure the deficiencies of *Gungabeesoon*. That is, *Margoscin* also fails to teach or suggest "the run-time code comprising a flag indicating whether the run-time code was generated from a native design-time representation or a converted design-time representation," as recited in claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 8 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 8 obvious to one of ordinary skill in the

art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 8.

Independent claims 1, 12, and 16, although different in scope from claim 8, are allowable for at least reasons similar to those given for claim 8. In addition, dependent claims 5-7, 11, 14, and 18 are allowable at least due to their dependence from allowable base claims 1, 8, 12, and 16. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 5-8, 11, 12, 14, 16, and 18 under 35 U.S.C. § 103(a).

Rejection of Claims 2, 9, 13, and 17 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 2, 9, 13, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Gungabeesoon* in view of *Margoscin* and *Doppelhammer*. A *prima facie* case of obviousness has not been established.

As discussed above, *Gungabeesoon* and *Margoscin* do not teach or suggest all the elements of independent claims 1, 8, 12, and 16, which are required by respective dependent claims 2, 9, 13, and 17. The Examiner cited *Doppelhammer* as allegedly teaching several elements of claims 2, 9, 13, and 17. *See* Office Action at 16-18. Even assuming that the Examiner's characterization of *Doppelhammer* is correct, which Applicants do not concede, *Doppelhammer* fails to cure the deficiencies of *Gungabeesoon* and *Margoscin*. That is, *Doppelhammer* also does not teach or suggest "the run-time code comprising a flag indicating whether the run-time code was generated from a native design-time representation or a converted design-time representation," as recited in claim 1. Therefore, a *prima facie* case of obviousness has

not been established with respect to claims 2, 9, 13, and 17. Accordingly, Applicants

respectfully request that the Examiner reconsider and withdraw the rejection of claims 2,

9, 13, and 17 under 35 U.S.C. § 103(a).
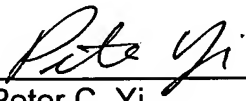
Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this

application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 14, 2008   By:_____
                                    Peter C. Yi
                                    Reg. No. 61,790
                                    202.408.4485